

Docket No.: 68066-013

PATENT



THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Appln. No. : 10/974,957
Reissue of U.S. Patent No. : 6,474,006 B1
Filing Date : October 27, 2004
Inventors : William G. Cummings et al.
For : Stabilizer Athletic Shoes
Art Unit : 3728
Examiner: : M.D. Patterson

Re: Protest Under 37 C.F.R. §1.291 Against Pending Reissue Application

Mail Stop Protest Against Pending Reissue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith is a Protest Under 37 C.F.R. Section 1.291 Against Pending Reissue Application.



No additional fee is required.

Applicant is entitled to small entity status under 37 CFR 1.27

Also attached: Cited References: Exhibit 1, U.S. Pat. No. 6,474,006; Exhibit 2, List of References (in attached notebook); Exhibit 3, Concise Explanation of Each Reference Relied Upon; Exhibit 4, Copies of Each Reference (in notebook); Exhibit 5, Reissue Application; Exhibit 6, '006 Patent File History



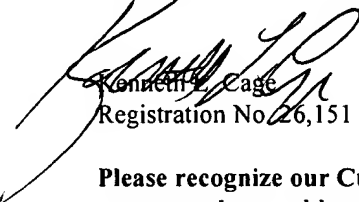
Please charge my Deposit Account No. 500417 in the amount of \$0.00. An additional copy of this transmittal sheet is submitted herewith.



The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment, to Deposit Account No. 500417, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


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Dear Sir:

Under the provisions of 37 C.F.R. §1.291, a protest against the above identified reissue application on U.S. Pat. No. 6,474,006 (“ ‘006 patent”) is directed. A copy of the ‘006 patent is attached. Exhibit 1. The real party in interest in filing this protest is NIKE, USA, Inc., (“NIKE”) who was sued for patent infringement of the ‘006 patent by Cummings et al. (or “Cummings”), *Dr. William G. Cummings and Dr. Jay G. Levine v. NIKE USA, Inc.*, Civil Action No. 04 Civ. 5099 (CLB) U.S.D.C. (S.D.N.Y.). That case was dismissed without prejudice, with Cummings filing the above identified reissue application seeking broader patent claims.

The basis of this protest is threefold. First, Cummings is improperly attempting to recapture subject matter aspects that they deliberately surrendered during original prosecution to avoid prior art. Second, Cummings is attempting to recant an admission they made as to necessary limitations of their shoe which distinguish it from the shoes disclosed in the prior art. Third, Cummings is attempting to patent reissue claim 5 which is anticipated by O’Brien, U.S. Patent No. 4,073,075.

Pursuant to 37 C.F.R. §1.291(a), this protest is being submitted prior to the date of any office action on the merits and hence prior to any mailing of a notice of allowance. A copy of this protest has been served upon Cummings according to 37 C.F.R. §1.248 as evidenced by the attached certificate of service. It is requested that this protest be entered into the application file.

It is requested that this protest be considered by the Office and brought before the examiner prior to the issuance of any office action. All required criterion of 37 C.F.R. §1.291(b) that are required to have the protest brought before the examiner have been met. Pursuant to 37 C.F.R. §1.291(b)(1)-(3), a listing of the prior art patents, publication or information relied upon is presented, Exhibit 2; a concise explanation of relevance of each is presented, Exhibit 3; a copy of each listed patent, publication or item of information is attached, Exhibit 4. Only patents in English are relied upon.

I. THE CUMMINGS ET AL. REISSUE APPLICATION

The above identified reissue application on U.S. Patent No. 6,474,006 was filed by Cummings et al. on October 27, 2004.¹ In a preliminary amendment,² Claims 1-4 were maintained and new claims 5-10 were introduced. Exhibit 5.

Claim 5, the sole independent reissue claim reads:

“A stabilizer athletic shoe comprising a sole having a bottom portion, a forefoot having a top portion, a rear foot portion, an edge and a heel portion, said forefoot portion having a medial part and a lateral part, and *a lateral foot stabilizer integral* with the edge of said sole.”

P1, Preliminary Amendment, ‘957 reissue application (*italics* emphasis supplied). The above *italics* phrase “*a lateral foot stabilizer integral*” in reissue claim 5 is but one of four distinguishing features that Cummings relied upon to obtain allowance of original patent claim 1 over the applied prior art. As is set forth below, claim 1 of the ‘006 patent reads as follows:

1. “A stabilizer athletic shoe comprising a sole having a bottom portion, a forefoot having a top portion, a rearfoot portion, an edge and a heel portion, said forefoot portion having a medial part and a lateral part, *an external lateral foot stabilizer* attached to the edge of said sole, *a bottom forefoot wedge member* attached to the bottom of said sole, *a medial heel wedge* having a bottom portion wherein said heel wedge spans substantially the entire length, and about one-half the width of said heel, and *a heel stabilizer* extending from the bottom portion of said heel to the top of the rearfoot portion.”

‘006 patent, C. 4, ll. 34-44 (*italics* emphasis supplied). All “four limitations” set forth in *italics* were required by the examiner to overcome the applied prior art. Now, Cummings is attempting

¹ Protester’s knowledge of this reissue application is based in-part on the Official Gazette notice of January 25, 2005. Protester has based the merits of this Protest on the official copy of the above-identified reissue application available from the U.S. Patent & Trademark Office (“USPTO”) on the PAIR data base website. A courtesy copy of the preliminary amendment was sent to NIKE by a representative of Cummings et al.

² The Preliminary Amendment bears the Attorney Docket: JWB-2000-5-P. Cummings stated that apart from adding claims in the preliminary amendment, no other amendment is made either in the specification or claims. Cummings’ declaration states that the error in the patent is that Cummings claimed more or less than they had a right to claim.

to recapture subject matter previously surrendered during the prosecution of the '006 patent. Exhibit 6. Because Cummings used a number of claim terms - often confusing and overlapping - to describe the various features of the claimed invention, a brief review of the '006 patent specification and Figs. 1-7 is appropriate.

A. The '006 Patent Specification and Drawings

In the '006 patent specification, Cummings identified what they admitted to be old and the features of their invention which are not shown in the prior art.

“Referring to FIGS. 1-3, there is shown, in FIG. 1, a sport shoe **10** having a flexible top portion **11** mounted on top of the shoe sole **12** and is tied around the top portion **11** by the shoe lace **13**. The sole **12** extends from the toe portion **15** to the heel portion **17** which may be rigid or semi-rigid in construction. The bottom or outsole **19** (see FIG. 2) may be ribbed, grooved or patterned as desired. *Such constructions are well known in the prior art.* For the purposes of the invention, in the embodiment shown in FIGS. 1-3, the shoe is provided with a lateral external stabilizer **21** ³”

'006 patent, C. 2, ll. 38-55 (*italics* emphasis supplied). Such an admission as to the scope of the prior art is binding on Cummings and only the lateral external stabilizer 21 is alleged to be new beyond the admitted prior art. See, *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (Fed. Cir. 1988), *cert denied*, 488 U.S. 892 (1988) (“A statement that something is prior art is binding on the applicant and patentee for determinations of anticipation and obviousness”).

Cummings then described their second embodiment of FIGS. 4-7:

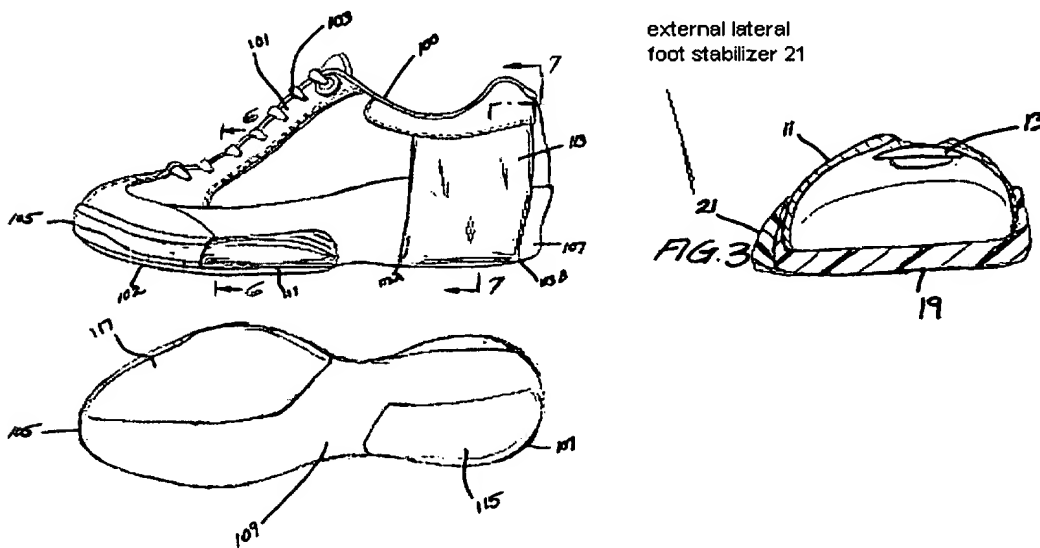
“In this embodiment of the invention, and as seen in FIGS. 4-7, the shoe **100** is provided with an *external lateral forefoot stabilizer 111, a lateral heel stabilizer 113, a medial heel wedge 115* and a *bottom forefoot wedge 117*, all of which contribute to the rigidity and dynamic stability of the shoe. The lateral forefoot

³ The phrase “a lateral external stabilizer **21**” originally read in the original specification “an external lateral forefoot wedge member 21.” This change was made in Paper No. 8/B.

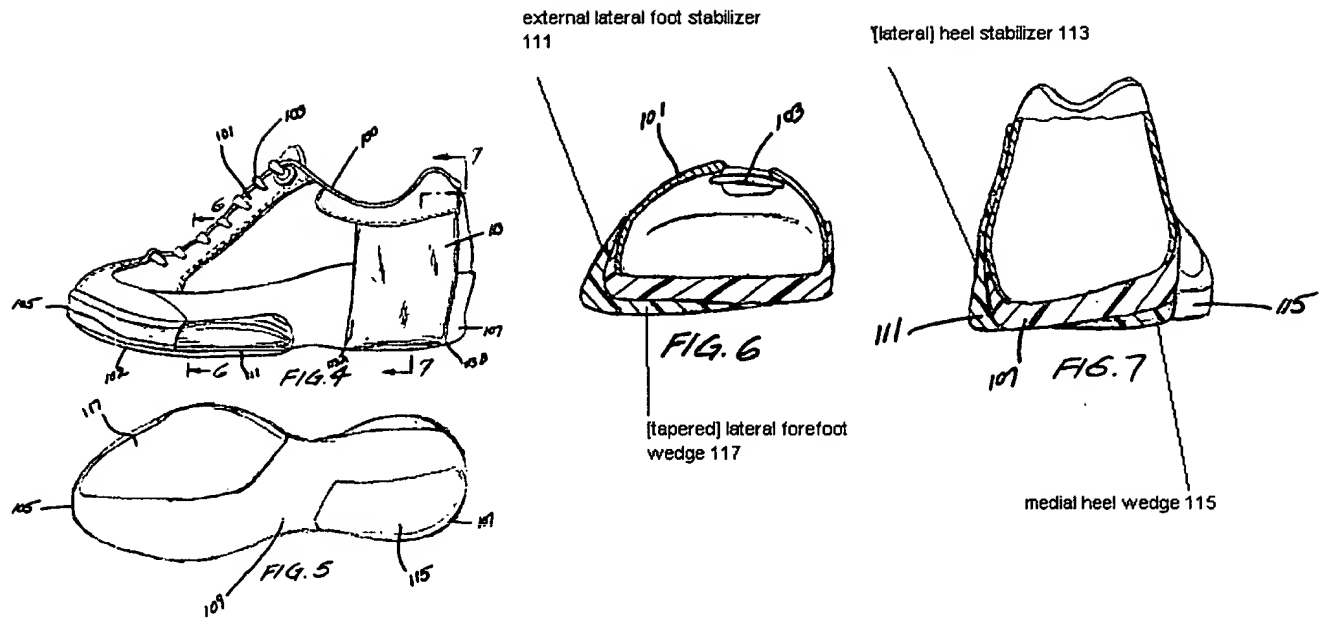
stabilizer **111** serves a similar function and purpose as the lateral forefoot stabilizer **21** described in connection with FIG. 1.”

'006 patent, C. 3, ll. 21-29, *italics* emphasis supplied. Again, as before, Cummings states that only the external lateral forefoot stabilizer **111**, a lateral heel stabilizer **113**, a medial heel wedge **115** and a bottom forefoot wedge **117** are alleged to be new beyond the prior art.

Turning to FIGS. 1-3 of the '006 patent, the first embodiment *showing the external lateral foot stabilizer 21* of original claim 1 is illustrated in Protester's mark-up shown below. See, C.2., l. 42 to C. 3, l. 7.



Turning now to FIGS. 4-7, the second embodiment showing *an external lateral foot stabilizer 111*, a *bottom foot wedge 117*, a *medial heel wedge 115* and a *heel stabilizer 113* of original claim 1 is illustrated in Protester's mark-up shown below. C. 3, l. 8 to C. 4, l. 26.



As illustrated in the above mark-up of FIGS. 1-7, it is apparent that Cummings' reissue claim 5 attempts to distinguish the prior art with only one of the four limitations, but set forth in a broader claim term – *a lateral foot stabilizer*. As is best illustrated in FIGS. 4-7 above, Cummings, in order to avoid prior art, surrendered any claim scope that fails include all four of the following limitations: (i) an external lateral foot stabilizer; (ii) a bottom forefoot wedge; (iii) a medial heel wedge; and (iv) a [lateral]⁴ heel stabilizer (“the four limitations”).

B. The ‘006 Patent File History - The Claims

Originally, claims 1-7 were filed with sole independent claim 1 reading:

“A athletic shoe comprising a sole having a forefoot portion and a rearfoot, said forefoot portion having a medial part and a lateral part, and a heel portion, wherein said forefoot portion includes *a lateral wedge member*, said lateral wedge member being tapered from the medial to lateral middle of the forefoot portion.

⁴ The bracketed word “[lateral] heel stabilizer” is shown in the FIG. 7 to point out the fact that Cummings used the term “lateral heel stabilizer 113” in the ‘006 specification and original claims. Notwithstanding Cummings’ statement that all of the claim 13 limitations (including “lateral heel stabilizer”) were included in amended claim 12, Cummings omitted the term “lateral” when they amended claim 12. Paper No. 14/E.

Depending on claim 1, claim 3 added the limitation "*lateral heel stabilizer*," claim 5 depending on claim 3 added the limitation "*medial heel wedge member*" and claim 7 depending on claim 3 added the limitation "*a bottom sole member including a tapered lateral forefoot*". Paper No. 1.⁵ Importantly, independent claim 1 having only the one limitation, "*a lateral wedge member*" - later rephrased to the claim 1 limitation "*an external lateral foot stabilizer*" - was rejected as anticipated.⁶ Further, all dependent claims were rejected as anticipated or obvious over prior art even though such claims had two or three or four of the above claim 1 limitations. Paper No. 2.

In response, Cummings cancelled claims 1-7, without prejudice, and added new claims 8-11, with sole independent claim 8 reading as follows:

8. A stabilizer athletic shoe comprising a sole having a forefoot portion, a rearfoot portion and a heel portion comprising a heel counter, said forefoot portion having a medial part, a lateral part, and *a lateral wedge member*[ed] *sic* tapered from said medial part to the middle of said lateral part, and said heel portion including *a lateral heel stabilizer* conformally attached to said heel counter and extending from the proximal end of said heel stabilizer to the distal end of said stabilizer.

Paper No. 4/A (*italics* emphasis added). Depending on independent claim 8, claim 9 did not add any of the additional "new" features, but claims 9 and 10 added the limitation "*a medial heel wedge*". In the office action, claim 8, having the two limitations of *a lateral wedge member* and *a lateral heel stabilizer*, was rejected as obvious over the prior art, and claims 9-11 were also rejected.⁷ Paper No. 5.

In response, Cummings cancelled claims 8-11, without prejudice, and added new claims 12-19, with sole independent claim 12 reading:

⁵ Dependent claim 2 modified the *lateral wedge edge* of claim 1, dependent claim 4 added the *lateral heel stabilizer* as in claim 3.

⁶ In Paper No. 2, the examiner rejected claim 1 as anticipated by Blissett, U.S. Pat. No. 5,444,839; claims 1 and 2 as anticipated by Talirico, II, U.S. Pat. No. 4,620,376; claims 1-4 and 6 as obvious over Noone, U.S. Pat. No. 4,866,861 in view of Lynn, U.S. Patent No. 2,179,942 and claims 1-7 as obvious over Blissett in view of Noone.

⁷ In Paper No. 5, claims 8 and 9 were rejected as obvious over Noone in view of Lynn and claims 8-11 as obvious over Blissett in view of Noone.

12. A stabilizer athletic shoe comprising a sole having a bottom portion, a forefoot portion, a rearfoot portion, an edge and a heel portion, said forefoot portion having a medial part and a lateral part, *an external lateral foot stabilizer* attached to the edge of said sole, and *a bottom wedge* attached to the bottom of said sole.

Paper No. 8/B. Depending on claim 12, claim 13 added the limitations of *a medial heel wedge* and *a lateral heel stabilizer*, but claims 14-19 did not add any of the necessary four limitations. In the office action, the examiner rejected claim 12 having two limitations – *an external lateral foot stabilizer* and *a bottom wedge* – as being obvious over prior art, but the examiner indicated that claim 13, having the other two limitations of *a medial heel wedge* and *a heel stabilizer*, was allowable if rewritten in independent format.⁸ Paper No. 9.

In response, Cummings amended claim 12 to include all four limitations - *an external lateral foot stabilizer; a bottom forefoot wedge; a medial heel wedge; and a heel stabilizer* - to overcome the applied prior art.⁹

By way of a summary, the following **Table** illustrates the fact that Cummings used inconsistent, overlapping and different lexicography for the four limitations necessary to distinguish the prior art during prosecution of the original application.

⁸ In Paper No. 9, claims 12, 14, 16 and 18 were rejected as anticipated by O'Brien, U.S. Patent No. 4,073,075.

⁹ Paper No. 14/E.

**Table - The Lexicography of the Claim Terms Used During Prosecution
Verses Claim Terms in Original Claim 1**

'006 patent claim 1/ Application claim(s)	external lateral foot stabilizer	bottom forefoot wedge member	medial heel wedge	heel stabilizer
Paper No. 1	lateral wedge member (ind. claim 1)	bottom sole member including a tapered lateral forefoot member (dep. claim 7)	medial heel wedge member (dep. claim 5)	lateral heel stabilizer (dep. Claim 3)
Paper No. 4/a	lateral wedge member[ed] ¹⁰ <i>sic</i> (ind. claim 8)	not included	medial heel wedge member (dep. claim 10.	lateral heel stabilizer (ind. Claim 8)
Paper No. 8/B	external lateral foot stabilizer (ind. claim 12)	a bottom forefoot wedge member (ind. claim 12)	a medial heel wedge (dep. claim 13)	lateral heel stabilizer (dep. claim 13)
Paper No. 14/E	external lateral foot stabilizer (ind. claim 12, amended)	a bottom forefoot wedge member (ind. claim 12, amended)	medial heel wedge (ind. claim 12, amended)	heel stabilizer ¹¹ (ind. claim 12, amended)
Reissue Preliminary Amendment	a lateral foot stabilizer (ind. claim 5)	a forefoot wedge member (dep. claim 7)	not included	not included

The prosecution history shows that when Cummings' claims had only one or two or three of the four limitations present, they were all rejected as unpatentable over the prior art. Further, even when Cummings' claims had all four limitations present, they were initially rejected over the prior art. Only after further prosecution involving an interview¹² with the examiner – where Cummings amended their lexicography of the four limitations in the specification and claims - did the examiner ultimately allow the “four limitations” claims.

¹⁰ In the “**REMARKS**” of paper 4/a, Cummings argues that their shoe is unique because of a *lateral foot stabilizer* and *heel stabilizer* even though the term *lateral foot stabilizer* was not present in the claims. Later in the **REMARKS**, Cummings then switched to the term *lateral wedge member* to distinguish Blissett *et al*.

¹¹ Although in the **REMARKS** of Paper No. 14/E, Cummings stated that: “...it was believed to be more practical to amend claim 12 to include *all of the limitations of claim 13*. . .”, this was not true. P. 6, Paper No. 14/E. The term “lateral heel stabilizer” was changed to read “heel stabilizer,” which broadened the claim beyond what the examiner indicated to be allowable. As was pointed out above, the specification provides support only for the term “lateral heel stabilizer.” C. 2, l. 13; C. 3, l. 23 and l. 38.

¹² Patent No. 6.

Now, in stark contrast to their surrender, Cummings seeks to reissue claim 5 having only “a lateral foot stabilizer,” which is a broader limitation than the claim 1 limitation of “an external lateral foot stabilizer.” Reissue claim 5 not only violates the reissue recapture doctrine, but it also ignores Cummings’ prior admission as to the combination of limitations necessary to avoid the prior art. It is also anticipated by O’Brien, U.S. Pat. No. 4,073,075.

II. CUMMINGS ET AL. ARE IMPROPERLY ATTEMPTING TO RECAPTURE CLAIM ASPECTS THAT WERE SURRENDERED DURING ORIGINAL PROSECUTION TO OVERCOME PRIOR ART

A. The Recapture Rule

The recapture rule is based upon the mandate of 35 U.S.C. §251 that reissue of a patent is available only whenever, through error without any deceptive intention, the patent is wholly or partly inoperative or invalid by claiming more or less than they had a right to claim in the patent. *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997) (“Under this rule, claims that are ‘broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution’ are impermissible.”) Deliberate withdrawal or amendment cannot be said to involve inadvertence or mistake contemplated by 35 U.S.C. §251. *See, Haliczzer v. United States*, 356 F. 2d 541 (Ct. Cl. 1966) (acquiescence in the rejection and acceptance of a patent whose claims include the limitation added by the applicant to distinguish the claims from the prior art shows intentional withdrawal of subject matter). Recapture prohibits a patentee from recapturing that which they previously surrendered in order to obtain allowance of the original claims. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993) (“The recapture rule bars the patentee from acquiring through reissue, claims that are the same or of broader scope than those claims canceled from the original application”).

Application of the recapture rule involves three steps. First, a determination is made whether and in what aspect the reissue claims are broader than the patent claims. Second, a determination is made regarding whether broader aspects of the reissue claims relate to the surrendered matter. *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997) (“To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.”). Third, a determination is made whether subject matter surrendered by Cummings has crept into the reissue claim 5. *See, In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997) (“Once we determine that an

applicant has surrendered the subject matter of the cancelled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this.”).

Here, the recapture rule applies because Cummings is seeking a broadened reissue claim 5 on aspects that they surrendered during prosecution to avoid prior art and that have crept into the reissue claim 5. Cummings cannot “recapture” subject matter that they relinquished.¹³

B. Whether and in What Aspects is Reissue Claim 5 Broader Than Patent Claim 1

Careful comparison of the reissue claim 5 to patent claim 1, set forth below, shows that the limitations of a bottom forefoot wedge, a lateral heel stabilizer, and a medial wedge in patent claim 1 – illustrated in *italics* type font - are not present in proposed reissue claim 5. Cummings’ attempt to delete these three surrendered limitations (or aspects) establishes that reissue claim 5 is broader than patent claim 1. The specific aspects of broadening are deleting the three elements of claim 1, shown in *italics*: *a bottom wedge member* and *a medial wedge* and *a heel stabilizer*. *Id.* Further, the term *lateral foot stabilizer* is a broader term than *external lateral foot stabilizer*.

¹³By way of comparison, the recapture rule does not apply in the absence of any evidence that applicant’s amendment was “an admission that the scope of the claim was not in fact unpatentable.” *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984) (“declining to apply the recapture rule in the absence of evidence that the applicant’s ‘amendment ... was in any sense an admission the scope of [the] claim was not patentable’ ”)

Claim 1 of Original Patent

“A stabilizer athletic shoe comprising
a sole having a bottom portion
a forefoot having a top portion
a rearfoot portion
an edge and a heel portion,
said forefoot portion having a medial part
and a lateral part,
an *external* lateral foot stabilizer attached to
the edge of the sole,

*a bottom wedge member attached to the
bottom of said sole,*

*a medial wedge having a bottom portion
wherein said heel wedge spans
substantially the entire length, and about
one-half the width of said heel, and*

*a heel stabilizer extending from the bottom
portion of said heel to the top of the
rearfoot portion.*

Application Claim 5 of Reissue

“A stabilizer athletic shoe comprising
a sole having a bottom portion,
a forefoot having a top portion,
a rearfoot portion,
an edge and a heel portion,
said forefoot portion having a medial part and
a lateral part,
and a lateral foot stabilizer integral with the
edge of said sole.”

C. The Broader Aspects of Reissue Claim 5 Relate To Surrendered Matter

As was described above, the prosecution history establishes that Cummings surrendered the particular aspects of the invention that they are now trying to recapture.¹⁴ In more detail, referring to the *italics* portion of claim 1 of the original patent and application claim 12 as set forth below, it is apparent that original application claim 12 included an external lateral foot

¹⁴ Cummings added the italics limitations based upon the prior art applied by the examiner. Specifically, the prior art applied by Office Action as identified by the “Paper No.” in the prosecution history is as follows: In Paper No. 2, the examiner rejected claim 1 as anticipated by Blissett, U.S. Pat. No. 5,444,839; claims 1 and 2 as anticipated by Talirico, II, U.S. Pat. No. 4,620,376; claims 1-4 and 6 as obvious over Noone, U.S. Pat. No. 4,866,861 in view of Lynn, U.S. Patent No. 2,179,942 and claims 1-7 as obvious over Blissett in view of Noone; In Paper No. 5 claims 8 and 9 as obvious over Noone in view of Lynn and claim 8-11 as obvious over Blissett in view of Noone; and In Paper No. 13 claims 12, 14, 16 and 18 as anticipated by O’Brien, U.S. Patent No. 4,073,075. There can be no question that the Patentee amended the claims in view of the prior art thus surrendering the aspects of the claim to obtain an allowance.

stabilizer and the bottom wedge element. However, that element alone was insufficient to obtain patentability as the examiner rejected claim 12 as anticipated by O'Brien. According to the examiner:

"O'Brien shows a shoe comprising *a forefoot wedge (10), a lateral stabilizer (13)* and a sole (21) and the wedge and stabilizer located in the forefoot portion (see column 5 line 3) ... ," Paper No. 13 (*italics* emphasis supplied).

In response, Cummings amended claim 12 adding most all of the limitations of claim 13 into claim 12 – but Cummings omitted the limitation *lateral* as a modifier to the term *heel stabilizer*. This amended claim 12 became claim 1 of the '006 patent, as illustrated below.

Claim 1 of Original Patent

"A stabilizer athletic shoe comprising
a sole having a bottom portion,
a forefoot having a top portion,
a rearfoot portion,
an edge and a heel portion,
said forefoot portion having a medial part
and a lateral part,
*an external lateral foot stabilizer attached to
the edge of the sole,*
*a bottom forefoot wedge member attached
to the bottom of said sole,*
*a medial heel wedge having a bottom
portion wherein said heel wedge spans
substantially the entire length, and about
one-half the width of said heel, and*
*a heel stabilizer extending from the bottom
portion of said heel to the top of the rearfoot
portion."*

Application Claim 12

"A stabilizer athletic shoe comprising
a sole having a bottom portion,
a forefoot portion,
a rearfoot portion,
an edge and a heel portion,
said forefoot portion having a medial part and
a lateral part,
*an external lateral foot stabilizer
attached to the edge of the sole, and*
*a bottom forefoot wedge member attached to
the bottom of said sole."*

	Application Claim 13
	<i>"A stabilizer athletic shoe as shown in claim 12, including a medial heel wedge spanning substantially the entire length, and about one-half the width of said heel, and</i>
	<i>a lateral heel stabilizer extending from the bottom of said heel to the top of the rearfoot portion."</i>

As illustrated in the above chart, it is clear that patent claim 1 includes all of the limitations of application claims 12 and 13. There is no question that Cummings' attorney ratified his admission that the features of a lateral foot stabilizer, a bottom wedge member and medial wedge member and a [lateral] heel stabilizer were all necessary to distinguish their invention over the prior art. Paper No. 8/B. This act of ratification of the attorney's admission by the amendment to claim 12 deliberately surrendered in the original prosecution that which patentee is now attempting to recapture. *See, Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993). It is in all senses an admission that the scope of reissue claim 5 is not patentable.

D. The Surrendered Subject Matter Has Crept Into The Reissue Claim 5

The final determination is whether subject matter surrendered by Cummings has crept into the reissue claim 5. A test approved by the Federal Circuit to make this determination is to compare the reissue claim with the cancelled claim. *See, In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997) ("... we then determine whether the surrendered subject matter has crept into the reissue claim. Comparing the reissue claim with the canceled claim is one way to do this.").

Here, as instructed by *In re Clement*, a comparison of the reissue claim 5 with canceled application claim 12 shows that the surrendered subject matter has crept into reissue claim 5. Application claim 12, which has all of the limitations of reissue claim 5, was rejected as anticipated under 35 U.S.C. § 102(b) by O'Brien, U.S. Pat. No. 4,073,075. Paper No. 13. Cummings acquiesced in the examiners' anticipation rejection of claim 12 and amended claim 12 to require all four limitations. Now, this surrendered subject matter has crept into reissue claim 5. *See*, Chart below.

Reissue Claim 5	Application Claim 12
"A stabilizer athletic shoe comprising	"A stabilizer athletic shoe comprising
a sole having a bottom portion,	a sole having a bottom portion,
a forefoot portion,	a forefoot portion,
a rear foot portion,	a rear foot portion,
an edge and a heel portion,	an edge and a heel portion,
said forefoot portion having a medial part and a lateral part,	said forefoot portion having a medial part and a lateral part,
<i>an lateral foot stabilizer</i> integral with the edge of the sole.	<i>an external lateral foot stabilizer</i> attached to the edge of the sole, and
	bottom forefoot wedge member attached to the bottom of said sole."

There is no question that Cummings seeks reissue claim 5 that is broader than rejected application claim 12, that Cummings surrendered aspects to distinguish their invention in application claim 12 over the prior art, and that Cummings has allowed the surrendered aspects to creep into reissue claim 5. Cummings is clearly attempting to recapture surrendered subject matter, which is prohibited by 35 U.S.C. §251.

III. CUMMINGS ET AL. MADE AN ADMISSION THAT ONLY A CLAIM WITH SPECIFIC LIMITATIONS DISTINGUISHED THE CLAIMED INVENTION FROM THE PRIOR ART

In soliciting the original '006 patent claims, Cummings faced a number of prior art rejections by the examiner on the then-pending claims. Turning to the '006 patent file history, Cummings cancelled original claims 1-7, paper no. 4/a, added and then canceled added claims 8-11, paper no. 8/B, and then proposed new claims 12-19, paper No. 8/B.

In arguing the patentability of claims 12-19 over the prior art to Noone, U.S. Patent No. 4,866,861, Lyne, U.S. Patent No. 2,179,942, and Blissett, U.S. Patent No. 5,448,839, Cummings made the following admission as to features necessary to distinguish the prior art:

“The added claims emphasize the features of the shoe which distinguish this shoe from the shoes disclosed in the prior art, particularly with respect to the following features:

- 1. the provisions of external lateral foot stabilizer and a bottom forefoot wedge which can partly overlap each other, and*
- 2. the provision of a lateral heel stabilizer and medial heel wedge.*

None of the cited prior art disclose or suggest the provision of these features in an athletic shoe.”

p. 3-4, Paper No. 8/B. (*Italics emphasis added*). This is a binding admission made by Cummings’ attorneys as to the content and scope of the prior art. What is admitted is that the claimed shoe of the ‘006 patent was distinguishable over the shoes in the prior art only because of a combination of provisions of specific limitations - an external lateral foot stabilizer and a bottom forefoot wedge, and a lateral heel stabilizer and a medial wedge. *See, Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (Fed. Cir. 1988), *cert denied*, 488 U.S. 892 (1988); *Tyler Refrigeration Corp. v. Kysor Industrial Group*, 776 F.2d 687 (Fed. Cir. 1985) (An admission by the applicants’ attorney that a patent was “the most pertinent available prior art known to the applicants and their representatives” made before the PTO is binding on the patent owner.) Although the then-pending independent claim 12 included two of the four limitations (*a lateral foot stabilizer and a bottom forefoot wedge*), and dependent claim 13 included the other two of the four limitations (*a lateral heel stabilizer and a medial heel wedge*), the fact remains that Cummings surrendered to the examiner’s requirement that the combination of all four features¹⁵ were needed to distinguish their shoe over the prior art.¹⁶

¹⁵ By way of illustration, patent claim 1 is reproduced with each of the four features in italics type font:

1. A stabilizer athletic shoe comprising a sole having a bottom portion, a forefoot having a top portion, a rearfoot portion, an edge and heel portion, said forefoot portion having a medial part and a lateral part, an *external foot lateral foot stabilizer* attached to the edge of said sole, a *bottom wedge member* attached to the bottom of said sole, a *medial wedge* having a bottom portion wherein said heel wedge spans substantially the entire length, and about one-half the width of said heel, and a *heel stabilizer* extending from the bottom portion of said heel to the top of the rearfoot portion.

¹⁶ In more detail, claim 12 was amended to overcome a 35 U.S.C. §102(b) rejection over O’Brien, U.S. Patent 4,073,075. As stated by the examiner in rejecting claim 12 above, “O’Brien shows a shoe comprising a forefoot wedge (10), a lateral stabilizer (13) and a sole (21) and the wedge and stabilizer located in the forefoot portion (see column 5 line 3) Paper No. 13. Applicants response was clear and unequivocal by adding the limitations of claim 13 (continued...) ”

Now, contrary to their attorneys binding admission as to the scope of the prior art, Cummings seeks reissue claim 5¹⁷ that has only one of the four limitations necessary to distinguish the prior art – a *lateral foot stabilizer*. Not only are three of the four limitations missing, but Cummings also seeks to broaden the ‘006 patent claim 1 term “*an external lateral foot stabilizer*” to read merely “*a lateral foot stabilizer*.” What Cummings attempts to do is jettison their binding admission that the other three limitations- *a bottom forefoot wedge and a lateral heel stabilizer and a medial wedge*- are necessary to distinguish the prior art. This not only contradicts their attorney’s admission, but it also ignores his attorney’s subsequent course of conduct in amending claim 12 to distinguish O’Brien. Such a binding admission cannot be recanted at the leisure of the applicants.

IV. REISSUE CLAIM 5 IS ANTICIPATED UNDER 35 U.S.C. §102 BY O’BRIEN, U. S. PATENT NO. 4,073,075

Reissue claim 5 is anticipated by O’Brien, U.S. Patent No. 4,073,075. As was stated by the examiner in rejecting application claim 12: “O’Brien shows a shoe comprising *a forefoot wedge* (10), *a lateral stabilizer* (13) and a sole (21) and the wedge and stabilizer located in the forefoot portion (see column 5 line 3),” Paper No. 13 (*italics* emphasis supplied). Because reissue claim 5 is broader than application claim 12 (as shown in Section II, D.), it is anticipated by O’Brien. *See, In re Bond*, 910 F.2d 831 (Fed. Cir. 1990) (“ ‘For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference.’ ”)

V. SUMMARY

Cummings is impermissibly seeking to recapture aspects of the invention that they deliberately surrendered during the original prosecution of the ‘006 patent. The recapture rule is a statutory requirement that a patentee’s deliberate withdrawal of subject matter aspects is an intentional act not contemplated by 35 U.S.C. §251. Cummings’ reissue conduct meets all of the

to claim 12. Paper No. 14. Based upon this surrender of these claim aspects, application claim 12 was allowed to issue as patent claim 1. Paper No. 15.

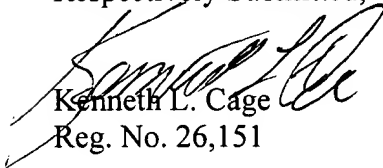
¹⁷ 5. A stabilizer athletic shoe comprising a sole having a bottom portion, a forefoot having a top portion, a rear foot portion, and edge and a heel portion, said forefoot portion having a medial part and a lateral part, and a lateral foot stabilizer integral with the edge of said sole.

criteria of the recapture rule. First, Cummings is seeking reissue claim 5 that is broader than their rejected application claims 1, 8 and 12. Second, Cummings surrendered aspects of the invention to distinguish application claims 1, 8 and 12 over the prior art. Third, Cummings has allowed the surrendered aspects of the invention to creep into reissue claim 5. Reissue claims 5-8 should be rejected and denied patentability under the recapture doctrine as they lack the requisite error without deceptive intent. 35 U.S.C. §251.

Not only has Cummings violated the recapture rule, but Cummings' attorney made an admission that all "four limitations" are necessary to avoid the prior art. Such an admission is binding on Cummings, which renders reissue claim 5 unpatentable because it lacks the four limitations.

Finally, reissue claim 5 is anticipated by O'Brien.

Respectively Submitted,



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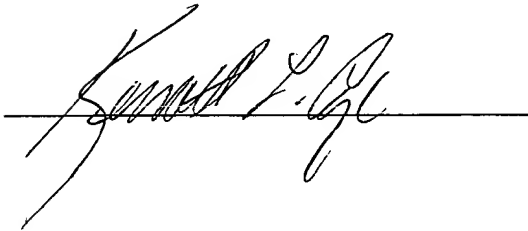
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Protest Under 37 C.F.R.
§1.291 Against Pending Application was served on this 12th day of March, 2005 on the following
in the manner of first class mail.

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List of Exhibits

Exhibit 1 - U.S. Patent No. 6,474,006

Exhibit 2 - List of References – Contained in the Attached Notebook

Exhibit 3 - Concise Explanation of Each Reference Relied Upon

Exhibit 4 - Copies of Each Reference (notebook)

Exhibit 5 - Reissue Application

Exhibit 6 - '006 Patent File History

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